

REMARKS

I. **Status of the Claims**

With entry of the amendments herein, claims 13, 15-22, 37, 39-46, 49, and 51 - 55, 57, 58, 60, 61 are pending in this application. Independent claims 13, 49, and 53 are amended herein to incorporate the phrase "wherein the human is an adult." Support for this amendment can be found throughout the specification, for example, at pg. 36, ll. 27 and pg. 24, ll. 1-14. Accordingly, no new matter is added by the amendments herein.

Applicants thank the Office for withdrawing the rejection under 35 U.S.C. § 103(a) of claims 54-55, 57-58, and 60-61 over Breivik et al. (U.S. Patent No. 5,502,077) ("Breivik") in view of Corkey et al. (U.S. Publication No. 2005/0019372) ("Corkey"). Office Action at 4.

II. **Rejection under 35 U.S.C. § 103**

The Office now rejects claims 13, 15-22, 37, 39-46, 49, and 51 - 55, 57, 58, 60, 61 under 35 U.S.C. § 103(a), as allegedly unpatentable over O'Connor et al. (U.S. Patent No. 6,596,302) ("O'Connor") and Breivik in view of Corkey. Office Action at 5. Applicants respectfully disagree and traverse this rejection for the reasons of record and the following reasons below.

The Office states that O'Connor teaches an improved nutritional composition containing DHA for pre-term infants (O'Connor at abstract) and that O'Connor teaches the ratio of DHA:EPA of 3:1. *Id.* at 5. The Office then argues that the limitations of claim 13 are encompassed because one skilled in the art would expect a formulation for

infants containing DHA:EPA to control the obesity (fat content) of infants. *Id.* at 5-6. Further, the Office says that it uses O'Connor to teach a higher percent concentration of DHA to EPA and render the invention obvious in combination with Breivik and Corkey. *Id.* at 9.

The Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418, 82 U.S.P.Q.2d 1385, 1396 (2007), stated that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR*, 127 S. Ct. at 1741 (emphasis added); see also 2010 *KSR Guidelines Update* effective September 1, 2010 ("Guidelines") (citing *Crocs Inc. v. International Trade Commission*, 598 F.3d 1294 (Fed. Cir. 2010) ("merely pointing to the presence of all claim elements in the prior art is not a complete statement of a rejection for obviousness.")). As subsequently held by the Federal Circuit, a proper support for a Section 103 rejection in the chemical arts requires the prior art to supply a reason or motivation to make the claimed compositions. See *Aventis Pharma Deutschland GmbH v. Lupin Ltd.*, 84 U.S.P.Q. 2d 1197, 1204 (Fed. Cir. 2007) (citing *Takeda*, 83 U.S.P.Q.2d at 1174). Here, the cited references fail to teach or suggest all the claim elements and provide a motivation to make the subject matter recited in the claims.

For example, Applicants disagree with the Office's characterization of O'Connor directed towards regulating obesity. O'Connor teaches "nutritional formulas, specifically enriched *infant* formulas that contain long chain polyunsaturated fatty acids (LCPs or LC-PUFAs); and to methods using such formulas to provide enhanced neurological developments in *infants*, specifically in *infants born prematurely* ("preterm" infants)."

O'Connor at Col. 1, ll. 9-14 (emphases added). Here, the Office attempts to stretch the teaching of regulating fat content in preterm infants to regulating obesity. In actuality, O'Connor teaches "catch-up" feeding regimens to increase calorie intake and prevent growth inhibition. *Id.* at col. 6, ll. 8-15. O'Connor does not mention controlling the fat content of infants but that DHA and AA are used to enhanced neurological development. O'Connor at Abstract. As such, O'Connor's teachings are taken out of context and do not teach regulating obesity as recited in the pending claims, even for infants.

In an effort to advance the prosecution, Applicants' amended the claims to recite "where in the human is an adult." With this amendment, the claims now explicitly disclose that the human population is adult. Since O'Connor is directed only towards an infant population and does not teach or suggest an adult population, O'Connor fails to teach or suggest all the elements of the pending claims. Breivik does not cure this deficiency of O'Connor.

Specifically, Breivik teaches an adult population (34-60 years) but fails to teach or suggest regulating or preventing obesity. Breivik at col. 6, ll. 24-25. In fact, Breivik only mentions that the adult population is "not extremely overweight." *Id.* at col. 6, ll. 35. As such, Breivik does not teach or suggest an adult population where obesity is regulated or prevented, as in the claimed invention. Similarly, O'Connor is also not directed towards regulating or preventing obesity. Instead, O'Connor is directed towards "catch-up" feeding regimens to increase calorie intake and prevent growth inhibition of infants. *Id.* at col. 6, ll. 8-15. One skilled in the art would not think that Breivik's "not extremely overweight" adults would need the "catch up feedings" taught

for infants in O'Connor. For this reason, one skilled in the art would not be motivated to combine Breivik and O'Connor because there would not be a reasonable expectation of success that the combination would arrive at the present claimed method of preventing or reducing obesity.

Turning to the secondary reference, Corkey also does not cure the deficiencies of O'Connor or Breivik. In fact, the Office cannot look to Corkey to teach or suggest an adult population because O'Connor and Corkey have different purposes.

Namely, Corkey describes "a dairy supplement or formulated diary product for consumption by infants or children to prevent development of obesity." Corkey at abstract. Corkey further explains that the dietary supplement is "for persons combating unwanted weight gain or obesity." *Id.* Moreover, that the supplement "can contribute to a reduction in body fat mass in individuals who are trying to loose [sic] weight or reduce body fat mass (e.g. obese individuals)." *Id.* From those teachings, although Corkey teaches an adult population, Corkey is directed towards *reducing* body fat mass and *reducing* calorie intake. In contrast, O'Connor teaches that the infant formula is designed to "catch-up" feeding regimens to *increase* calorie intake and *prevent* growth inhibition. O'Connor at col. 6, ll. 8-15. "If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." M.P.E.P. § 2143.01(V) (citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)). Thus, the contradictory purposes estops any motivation or suggestion to combine or modify.

For the foregoing reasons, Applicants submit that O'Connor, Breivik, and Corkey, alone or in combination, fail to teach or suggest all the claim elements and fail to

motivate one skilled in the art to modify the cited art compositions to arrive at the claimed inventions. As a result, the cited references fails to establish a *prima facie* case of obviousness and to that end, Applicants respectfully request the withdrawal of the rejection.

III. Conclusion

Applicants submit that the above amendments and remarks overcome the rejection of record over the present claims. Accordingly, withdrawal of the rejection and timely allowance of the pending claims is respectfully requested. Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 
Adriana L. Burg
Reg. No. 48,564